

REMARKS

Prior to entry of this Amendment and Response, claims 2-10 and 12-42 are pending in the application. This paper cancels no claims. Accordingly, after entry of the response, claims 2-10 and 12-42 remain pending.

I. Claim Objections- Claims 25, 30 and 40

The Examiner objected to claims 25, 30 and 40 for various informalities. Specifically, the Examiner requested the word "and" be inserted in claim 25 between "configuration" and "a", the word "wherein" be inserted into claim 38, and the word "integral" be removed from claim 40. The Applicant has amended these claims accordingly.

II. Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 2-10 and 12-42 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner alleges the specification does not disclose how the observation window 14 of the present invention is adapted to isolate the light source from the lumen, as claimed in claim 41. In response thereto, the Applicant has amended claim 14 to more particularly recite the relationship between the observation window, speculum interior, insufflation chamber, and coupling means. The Applicant respectfully submits this amended claim 41 overcomes the Examiner's rejection under § 112.

Next, the Applicant has amended claims 41 and 42 to eliminate the reference to a "connection means," instead reciting the limitation of a "coupling means" instead. Further the Applicant has amended claim 41 to indicate the coupling means comprises "a light head housing a light source," thus eliminating any confusion as to whether the light head and coupling means are different.

The Applicant has also amended claims 2 and 18 to change the antecedent basis of the phrase "the contamination means" to read "a contamination means."

For at least the foregoing reasons, the Applicant respectfully submits the Examiner's rejections under 35 U.S.C. § 112 are overcome. Accordingly, the Applicant respectfully requests the Examiner withdraw the rejections.

III. Rejections Under 35 U.S.C. § 102- Fiore

The Examiner rejected claims 41, 42, 10, 12-17 and 21-24 under 35 U.S.C. § 102(b) as anticipated by United States Patent No. 3,889,661 to Fiore (hereinafter "Fiore"). The Examiner alleged Fiore teaches all elements of each of these claims. For at least the following reasons, the Applicant disagrees.

Fiore teaches a transparent flange wall 19 defining an inwardly-projecting annular window, which, in combination with a cylindrical section 18, isolates a recess 27 (in which a light head 25 sits) from the interior of the barrel 11 (see Fig. 1 and col. 4, lines 7-23). The flange wall permits "a lighting means in handle or lighting unit 12, and behind wall 19, [to] transmit light down barrel 11 to the distal end" (col. 4, lines 17-19). The Examiner alleges this transparent wall 19 anticipates the observation window of the present invention. As the Examiner stated in his Office action at paragraph 7, "As to the newly added limitation to the 'observation window adapted to isolate the light source from the lumen,' note window (18,19)..." This rejection ignores certain fundamental differences between the claimed observation window and Fiore's structure.

First, although Fiore's transparent wall (18, 19) permits light to enter Fiore's barrel 11, it is not an observation window. An operator cannot look through Fiore's transparent wall, due to its location within the barrel 11; view through the window is blocked by the annular part 26, which surrounds the transparent wall and is itself opaque. Instead, an operator looks through a lens 33 formed in an end cap unit. In particular, "end cap unit 32 is usually provided with an optical lens 33 to facilitate examination" (col. 6, lines 54-55; see generally col. 4, lines 45-58).

Additionally, the Applicant has amended independent claim 42 to more clearly require that the fluid-tight observation window extend "across the observation end of the speculum" and define, "in combination with the interior of the speculum... a fluid-tight insufflation chamber isolated from the coupling means." Fiore's transparent wall (18, 19) cannot anticipate this limitation, because it does not extend across the observation end of the speculum. Likewise, Fiore's lens 33 cannot anticipate this limitation, because the lens does not "isolate the light source from the lumen," as required by independent claim 42. In any event, the chamber partially defined by Fiore's lens 33 is not an "insufflation chamber," as required by independent claim 42.

Next, the Applicant notes the Examiner alleges that the “tube conveying the insufflation medium does not contact the annular part (26)” in Fiore (Office action, paragraph 7). The Applicant respectfully submits Fiore teaches merely that the insufflation medium is isolated from the light *source* (i.e., lamps 25), but not the lighting *head* 24.

Fiore discloses that “both suction and pressure is applied [to insufflate the colon] through a nipple or conduit 34 which projects from lighting head 21 and communicates to the interior of barrel 11 through an appropriate opening or slot 35 (not shown) in cylindrical section 18”) col. 6, line 67 to col. 7, line 3). Thus, the insufflation medium must necessarily pass through the conduit 34, which is defined in the lighting head 24 (Fig. 1; *Id.*).

By contrast, amended claim 42 requires that “the insufflation medium [is] conveyed directly from the insufflation means to the insufflation chamber by a gas conveying insufflation tube without contacting the coupling means.” The Examiner has alleged that the “coupling means” of the present invention is anticipated by the lighting head 24 of Fiore (paragraph 7 of the Office action). Accordingly, since Fiore teaches that the insufflation medium *must* pass through the lighting head, it cannot anticipate independent claim 42, which requires the insufflation medium to *not* contact the coupling means.

For at least the foregoing reasons, the Applicant respectfully submits Fiore cannot, and does not, anticipate amended independent claim 42. The Applicant therefore respectfully requests the Examiner withdraw his rejection and allow claim 42 over the cited reference.

The remaining rejected claims depend, either directly or indirectly, from independent claim 42. Insofar as independent claim 42 has been shown to be patentable, these dependent claims are also patentable. The Applicant makes this statement without reference to or waiving the independent bases of patentability within each such dependent claim. The Applicant therefore respectfully requests the Examiner withdraw his rejections and allow the dependent claims over the cited reference.

IV. Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 2, 3, 5-8, 15-24, 28, 30, 31 and 33-40 under 35 U.S.C. § 103(a) as rendered obvious by the combination of Fiore and Japanese Publication No. 06-319691 to Sugiyama. The Examiner likewise rejected claims 4, 9, 29 and 32 under 35 U.S.C. § 103(a) as rendered obvious by the combination of Fiore and United States Patent

No. 5,061,239 to Shiels. Additionally, the examiner rejected claim 25 under 35 U.S.C. § 103(a) as rendered obvious by the combination of Fiore and United States Patent No. 5,176,127.

The Applicant notes each of these dependent claims depend, either directly or indirectly, from independent claim 42. Insofar as independent claim 42 has been shown to be patentable, these dependent claims are also patentable. The Applicant makes this statement without reference to or waiving the independent bases of patentability within each such dependent claim. The Applicant therefore respectfully requests the Examiner withdraw his rejections and allow the dependent claims over the cited references, alone or in combination.

V. Allowable Subject Matter

The Applicant thanks the Examiner for his indication that claims 26 and 27 would be allowable if rewritten in independent form, including all limitations of the base claim and any intervening claims. However, since the Applicant has demonstrated herein the allowability of all pending claims, the Applicant has at this time declined to rewrite claims 26 and 27 in such a manner. The Applicant reserves the right to rewrite these claims in independent format at a later date, if necessary.

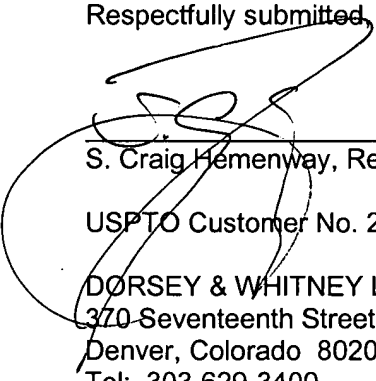
VI. Conclusion

This Amendment is submitted contemporaneously with a Request for Continued Examination and a petition for a three-month extension of time in accordance with 37 CFR § 1.136(a). Accordingly, please charge Deposit Account No. 04-1415 in the amount of \$1,810.00 (\$790.00 for RCE fee and \$1,020.00 for three-month extension of time fee). The Applicant believes no further fees or petitions are required. However, if any such petitions or fees are necessary, please consider this a request therefor and authorization to charge Deposit Account No. 04-1415 accordingly.

If the Examiner should require any additional information or amendment, please contact the undersigned attorney.

Dated: 12/16/05.

Respectfully submitted,



S. Craig Hemenway, Registration No. 44,759

USPTO Customer No. 20686

DORSEY & WHITNEY LLP
370 Seventeenth Street, Suite 4700
Denver, Colorado 80202-5647
Tel: 303-629-3400
Fax: 303-629-3450